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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,094	01/02/2002	John A. Benda	67,007-005; R-4264	8685
26096	7590	04/13/2004	EXAMINER	
CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/039,094

Applicant(s)

BENDA ET AL.

Examiner

John Hoffmann

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/2/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

John Hoffmann
Primary Examiner
Art Unit: 1731

4-9-04

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection based on 35 USC 112 (1). The rejection of claims 24-25 and 27-28 under 35 USC 112 (2) [but not for claim 23].

Continuation of 5. does NOT place the application in condition for allowance because: The rejection based on 35 USC 112 (1) has been overcome. The rejection of claims 24-25 and 27-28 under 35 USC 112 (2) [but not for claim 23] has been overcome by the arguments. Regarding claim 23 Applicant refers to "another first locality". The claim does not require another first locality. The claims only mention one first locality, and one second locality. Therefore the arguments are not convincing. If one repeats the step of directing a laser beam onto a first locality, a laser is directed to that (same first) locality. In as much as Applicant argues that 48 and 52 are two different beams simply because they hit on two different locations, one cannot then say two different locations are the first locality. More over if there can be other first localities, can there be other fibers? If the rules for antecedent basis are suspended for "locality", it is unclear if the rules should also be suspended for "fiber".

It is argued that beam 14 of Byron shines on the same locality as which beam 11 shines and thus there is no displacement as required by the claims. This is a mischaracterization of the rejection. The rejection specifies that the "first locality" is just the left most portion of the exposed to and altered by beam 11. Applicant's arguments neglect that the Office has determined that just the left most portion is the "first locality". The claim is very broad and does not prohibit the beam from also impinging upon other localities. Especially note claims 23 and 26 (and page 3, line 18 of paper of 02 April 2004) which Applicant argues that there can be "another first locality". It is also noted that Applicant has two different beams (see figure and page 5 of specification as well as the paper of 02 April 2004) in which it is merely one laser creating a beam - and then a mirror directs it in two different manners - Applicant argues that these two different reflections result in two different beams. One can apply the same rationale to Byron: instead of a mirror, a grating is used to create a fringe pattern (col. 1, lines 58-61). Each maxima of the fringe would correspond to a different locality. Applicant has not indicated a definition for "locality" which would exclude the left-most portion exposed to the beam.

It is further argued that there is a distinction between Byron and the present invention. Any distinction is not captured by sufficiently narrow claims that exclude the Byron method.

Applicant argues that there is no suggestion to modify the Byron. This argument is not persuasive, because the prior art need not be the source of the suggestion. Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). For example, making things portable, integral, separable, adjustable, automatic are a few obvious modifications that are well-established by case law. The Office has never indicated that the modification (of the rejection) was derived in the prior art. The rejection clearly states the complete rationale for the holding that the invention was an obvious one. Furthermore, if the Office had taken the position that Byron provided the motivation, the rejection would have been under 35 USC 102 anticipation. Since Applicant has not given any indication that it one would not have been motivated to make additional gratings, it is deemed that Applicant agrees that one of ordinary skill would have been motivated to make additional gratings.

It is also argued that Bernstein does not teach deforming the optical fiber as claimed. The rejection clearly indicates that Bernstein deforms a fiber (by stripping it) so as to create a grating. It is unclear what Applicant regards as the error in the rejection. Whereas Applicant deforms the fiber differently than Bernstein, the claims are not limited to Applicant's disclosed embodiments.

It is further argued that Bernstein does not have enough power to effect the core and cladding. The rejection is based on two references: Bernstein is relied upon for a low power laser which deforms the fiber to make a grating in a later step, then the Byron laser is used to thereby form the grating. The present claim does not require that the deformation creates the grating: the "to form the grating" is not interpreted to mean "thereby forming the grating". Claim 4 does not require any link between the forming step and step C of claim 1 - rather, it appears claim 4 requires a completely new step that apart from the steps of claim 1.

Regarding Kim Applicant again argues the same point as with Byron: the motivation to modify does not come from the prior art. This is largely irrelevant, motivation need not originate in a prior art reference. Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Mere duplication of parts has no patentable significance unless a new and unexpected result is produced *In re Harze* 124 USPQ 378 (CCPA 1960). Mere duplication of a grating has no patentable significance. It is argued that there is no showing of the two localities in the Prast/Nakai rejection. The rejection clearly points out how the claim limitations are met. There is no indication what specific error Applicant has found in the rejection - so Examiner cannot say much more. It is also alleged that there is nothing in Prast that indicates the references can be combined. Prast can be used in nearly any fiber drawing process and one who has possession of Prast and Nakai would immediately recognize the value in using the Prast improvement with the Nakai method..